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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/329,734

06/10/1999

IRVING AMES

YO999-023

8493

7590

08/24/2005

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New Milford, CT 06776

EXAMINER

EISEN, ALEXANDER

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/329,734

Applicant(s)

AMES, IRVING

Examiner

Alexander Eisen

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11, 14-17, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11, 14-17, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 7-11 and 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 09 June 2005, PROSECUTION IS HEREBY REOPENED. New ground of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Applicant's argument relative to the Fukuhara reference have been found persuasive and therefore the rejections based on this reference are withdrawn.

Claim Objections

3. Claims 16 and 17 are objected to because of the following informalities: claims 16 and 17 are shown as dependent from claim 12, which has been cancelled by the preceding amendment. Apparently this dependency should be from claim 21. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 6-11, 14-17 and 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Independent claims 20 and 21 recite limitations "the addition of 20-50% increase in weight of said mouse input member". It is not clear, does this limitation means that any mouse of any weight needs to be improved by an "addition of 20-50% increase", or a mouse weighting, for example, 120 grams already constitutes the improvement over a mouse weighting 100 grams, according to the Applicant. The claim language is found to be indefinite because one of ordinary skills in the art, and for that matter any person, would not be able to practice the invention since this person is not explicitly directed to of to what original weight of a mouse this invention should be applied to. The specification on page 5 states: "At the present state of the art, the weight of a mouse can be about 100 grams or about 3.5 ounces. But at that weight, while light enough to avoid hand fatigue, difficulty in positioning can be encountered". So the Applicant's invention suggests to increase the total weight of such a mouse by 20-50% (which would increase hand fatigue, but would improve the positioning?). The invention also claims "a positioning control enhancing increment to said drag type resistance frictional force component that operates to enhance resistance to said relative movement of said mouse member over said surface of said mouse pad, said positioning control enhancing increment to said drag type resistance frictional force being control enhancing means selected from the group consisting of the addition of 20-50% of the weight of said mouse member". Again, without quantitative presentation of "drag type resistance frictional force component" one of ordinary skill in the art would not be able to practice the invention, because as can be derived from the Applicant's

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assertion, the increased weight can cause hand fatigue and therefore those individuals would not know where to stop increasing that frictional force. The specification does not provide any data concerning this problem. As it would also be readily understood, there are many type of mouse having various weights, also the variety of users would apply different force and pressure onto the “mouse member” causing the myriad of various frictional forces, and the Applicant does not provide the tool of which one to pick. On the other hand the Applicant states that the “average” mouse can weight about 100grams, which means that that “average” mouse can encompass mice ranging from 80-120 grams and then a mouse weighting 120 grams would represent, from the Applicant point of view, improvement over a mouse weighting 80-100 grams.

7. Since the Applicant’s statement above, i.e. that “at the present state of the art, the weight of a mouse can be about 100 grams or about 3.5 ounces”, is not supported by any evidence, the examiner respectfully requests any available to the individuals identified under 37 CFR 1.53(c) information in support of this statement under 37 CFR 1.105.

Requirements under 37 CFR 1.105

8. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The information is required to complete the background disclosure is such as pertinent documents, user guides and/or specifications disclosing the weight of various types of mouse preceding the invention, which can support the Applicant’s statement that the average mouse weight “at present state of the art” is about 100grams.

Claim Rejections - 35 USC § 103

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 20, 21, rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al., US 4,751,505 in view of admitted prior art.

Williams et al. discloses a mouse weighting about 3 ounces (col. 2, lines 49-52). While Williams et al. does not teach an improvement of adding the weight to the mouse, by the admission of the Applicant the mouse of the state of the art at the time of the invention weights approximately 100 g or 3.5 ounces.

With respect to claim 20 and 21 it would have been obvious to one of ordinary skill in the art at the time when the invention was made that in view of the Applicant the “average mouse” would constitute the alleged improvement over the mouse of Williams.

As to claim 6, it would have been obvious to one of ordinary skill in the art that the increase of the “average” mouse over the mouse of Williams et al., is approximately 20 g.

Allowable Subject Matter

11. Claims 7-11 and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The reasons for the indication of allowable subject matter are clear from the claim limitations, which in combination with parent claim are not participated or otherwise obvious over the cited prior art.

Conclusion

13. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Affinito et al., US 4,868,549, discloses a mouse having an electromagnetic force feedback.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (571) 272-7687. The examiner can normally be reached on M-F (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Eisen
Primary Examiner
Art Unit 2674

8-19-05